Remarks

Claims 1-33 are pending. Claims 1 and 7-9 have been amended. Support for amended claim 1, can be found at least in original claim 7. Claims 7-9 have been amended to remove redundancies made by amending claim 1.

In response to the restriction requirement of October 4, 2004, applicant provisionally elects the Group I (claims 1-28) with traverse. Applicants also provisionally elect species i (CTLA4-Ig) with traverse. Additionally, applicants have amended claim 1 to recite an "anti-CD3 immunotoxin."

Applicants also request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P. § 803 provides:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden.

Applicants respectfully assert that the Examiner has not shown that the second requirement has been met, on the basis that the Examiner has not shown that it would be serious burden to search and examine all of the claims together.

For the reasons stated above, applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Examining all of the claims together would eliminate the necessity of prosecuting multiple, separate, yet intimately related, applications. Thus, applicants respectfully request that

all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Additionally, Applicants respectfully point out that as discussed in 37 C.F.R. § 1.141(a), an application may claim a reasonable number of species within a claimed genus as long as at least one genus claim encompassing all of the species is patentable. The Examiner has indicated that a *specific* species of co-stimulation blockers, must be elected. Applicants first note that the Examiner has placed into separate species blockers of a ligand and the corresponding receptor of the same pathway (e.g., species ii is anti-CD40 ligand and species iii is anti-CD40). Applicants note that species i is the receptor for species iv and v. A search for any of the species for any of species i, iv, or v would necessarily be a search for all of species i, iv, and v because it would be unlikely to find any reference to a ligand or a receptor that did not also discuss that to which it binds. Similary, species ii is the ligand for species iii. A search for species ii would necessarily also be a search for species iii. Therefore at the most there are only two species. Applicants assert that this is not an appropriate application of the 37 C.F.R. § 1.141, which is aimed at situations where there are unreasonable numbers of species is claimed. The present situation is not a situation where the applicants are claiming a genus of compounds, for example, a set of 1000 different nucleic acid molecules, and also claiming each of the encompassed species separately, which would be an appropriate application of the election of species requirement. Rather, applicants have claimed a method having a defined number of steps, and then claimed a reasonable number of dependent variations on that method. Applicants are not required in the present application to elect a species when applicants have not claimed an unreasonable number of species.

Furthermore, applicants traverse the restriction requirement for the following reasons. To be valid, a restriction requirement must establish both that (1) the "inventions" are either independent or distinct, and (2) that examination of more than one of the "inventions" would constitute a burden to the Examiner. Applicants note that the restriction/election requirement does not provide sufficient basis to indicate that examination of more than one of the "inventions" would overly burden the Examiner. Applicants thus respectfully request reconsideration of the election requirement.

The Examiner has also invited the Applicants to amend claim 1 to recite an anti CD3 immunotoxin or face a species election regarding the genus of immunotoxins. Although applicants believe that such a restriction would not be valid because only one species is claimed, applicants have amended claim 1 to recite "an anti-CD3 immunotoxin." Applicants believe that any potential species election is now moot.

Applicants also wish to remind the Examiner of the guidelines for rejoinder of claims as set forth in M.P.E.P. § 821.04, as they apply to the pending claims of the instant application.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of $110.00 is enclosed for a Request for a one-month Extension of Time. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Gwendolyn D. Spratt — 12-6-04

Gwendolyn D. Spratt — Date